



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,552	03/04/2002	Robert J. Macomber	P 279036	5327
909 7590 09/24/2007 PILLSBURY WINTHROP SHAW PITTMAN, LLP Eric S. Cherry - Docketing Supervisor P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER HYUN, PAUL SANG HWA	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/086,552

Applicant(s)

MACOMBER, ROBERT J.

Examiner

Paul S. Hyun

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1743

DETAILED ACTION

REMARKS

In response to the Office action mailed March 8, 2007, Applicant amended claims 1 and 3-5, and added new claims 15-19. Claims 10-14 remain withdrawn. In summary, claims 1-8 and 10-19 are currently pending with claims 10-14 being withdrawn.

The new matter objection and the rejection have been withdrawn in light of the amendments.

Despite the amendments, the art rejections are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-5, 7, 8 and 15-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino (US 6,132,684) in view of Emmitt (US 4,124,122).

Marino discloses a test tube rack 100 comprising three plates (102, 104 and 106) supported by legs 115 and pins 120 and an actuating handle assembly 144 comprising an actuating handle 154. Each plate comprises machined holes 108, and the corresponding holes of the plates are configured to align with one another (see FIG 2). Plate 106 is also capable of shifting in a horizontal direction with respect to the other plates to provide a means to secure the tubes placed therein (see claim 1). When a manipulating mechanism in the form of actuating handle 154 is moved into a horizontal

Art Unit: 1743

engaging position, plate 106 shifts and firmly secures the test tubes 184 in their corresponding tube accommodating holes 114 (see lines 35-42, col. 7). The actuating handle assembly 144, which supports the three plates and facilitates the horizontal movement of plate 106 (see lines 47-57, col. 6), is spring biased (see Figs. 10-12) and adjustable by adjusting the positions of blocks 146 (see lines 32-40, col. 6).

Although the reference does not specifically disclose that the rack is adapted to store the different types of filaments recited in the claims, the dimensions of the holes of the Marino rack appears to be within a range suitable for accepting a "filament" as defined in the Specification of the instant application.

The rack disclosed by Marino differs from the claimed invention in that the reference does not disclose that the holes are chamfered.

Emmitt discloses a test tube rack adapted to accommodate test tubes. The surface defining each hole of the test tube rack comprises a groove/chamfer in which is disposed an O-ring. The O-ring is adapted to secure the test tubes within the rack by frictionally engaging the test tubes (see Abstract).

In light of the disclosure of Emmitt, it would have been obvious to one of ordinary skill in the art to chamfer the holes of the rack disclosed by Marino so that they would be able to accommodate O-rings that can frictionally engage the test tubes.

With respect to claims 3-5 and 17-19, it should be noted that the claims do not further limit the claimed invention because the filaments are not part of the claimed invention.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marino in view of Emmitt as applied to claims 1-5, 7, 8 and 15-19, and further in view of De Graaff et al. (US 6,146,594).

Neither Marino nor Emmitt specifically disclose the arrangement of the holes of a test tube rack. However, the hole matrices recited in the claim are well known in the art. De Graaff et al. disclose that the Society of Biomolecular Screening has standardized well plate arrangements on a variety of plate formats. Some established arrangements include 96 and 384 well plate designs (see lines 15-25, col. 1).

It would have been obvious to one of ordinary skill in the art to provide the modified Marino rack with 96 or 384 holes in a matrix format so that a large number of test tubes can be accommodated.

Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but they are not persuasive.

First, Applicant argues that the limitation "filaments that collect a small portion of a sample via contact with the sample" recited in the claims distinguishes the claimed invention from the test tubes disclosed by Marino, which are incapable of collecting a sample via contact with the sample. This argument is not persuasive because the amendments do not further limit the actual claimed device. Rather, the amendments further limit the filaments, which do not further limit the claimed invention because the filaments are not part of the claimed invention according to the claim language. Because the filaments recited in the claims are not part of the claimed invention,

Art Unit: 1743

limitations directed towards the filaments cannot be the basis for overcoming the cited references. The claims do not explicitly recite that the claimed invention comprises the filaments. Rather, the claims recite that the claimed invention comprises a device for manipulating and dispensing multiple filaments wherein the device comprises:

at least three plates each having a plurality of machined holes of a predetermined diameter, wherein the at least three plates are configured to adjustably align to one another, and at least one of the at least three plates may be shifted in a horizontal direction with regard to the remaining plates to secure the multiple filaments in the device, and wherein at least one of the three plates contains holes that have a chamfered surface at a top or bottom thereof; and a holding mechanism configured to orient and support the at least three plates

According to the claim language, the invention does not comprise filaments.

It can be argued that the limitation is patentably significant because the limitation implicitly limits the size of the machined holes to a certain range. However, the limitation fails to patentably distinguish the claimed invention from the prior art because the size implicitly associated with the limitation "filaments" is broad enough such that the dimensions of the holes disclosed by Marino are within the scope of the implied size range.

Applicant also argues that Marino fails to disclose the method of using a device to manipulate multiple filaments to collect a sample, and that this distinction overcomes the disclosure of the prior art. This argument is not persuasive. The limitations directed toward the manipulation of the filaments do not further limit the claimed invention

Art Unit: 1743

because the limitations are directed towards the intended use of the claimed invention, which alone cannot be the basis for patentability. A device that is CAPABLE of accomplishing the acts recited in the claim is considered to be within the scope of the claimed invention. In this case, although Marino does not disclose the method of manipulating filaments using the rack, the Examiner maintains the position that the rack disclosed by Marino is capable of, and thus configured to, manipulate filaments in the manner recited in the claims if filaments were to be stored in the rack.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

Art Unit: 1743

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
9/17/07


Jill Warden
Supervisory Patent Examiner
Technology Center 1700